

REMARKS

Claims 1-29 are currently pending in the subject application and are presently under consideration. Claims 1, 23, and 26 have been amended as shown on pp. 2-6 of the Reply.

Applicants' representative thanks the Examiner for the telephonic interview conducted 05 June 2008 at 3pm EST. Applicants' representative further appreciates that the Examiner indicated that the amendments to the claims is sufficient to overcome the 35 U.S.C. § 101 rejection. The Examiner is requested to reference figures 2-4, 10-12 and 34-40 in regard to the extensive discussion during the interview of natural language editors and inline editors being terms of art such that a natural language inline editor would also be clear and unambiguous to one of skill in the art under the plain meaning of the terms. The figures illustrate the use of natural language that comports with the definition discussed from the Microsoft Computer Dictionary 5th Ed. Further, natural language inline editing is discussed on pg. 6, ln. 30 - pg. 7, ln. 9 of the current specification. As discussed the current cited art does not illustrate these features.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-21, 23 and 26 Under 35 U.S.C. §101

Claims 1-21, 23 and 26 stands rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 23, and 26 have been amended to incorporate physical structure and thus are not directed to software *per se*. Where the claims now properly recite the requisite physical structure, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 101 in regard to claims 1-21, 23, and 26.

II. Rejection of Claims 1-29 Under 35 U.S.C. §103(a)

Claims 1-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Beaumont et al. (2004/0073511) (hereinafter "Beaumont"). Claims 1-29 stand rejected under 35 U.S.C. §102(e) as being anticipated by Beaumont *et al.* (2004/0073511) presumably in light of Burke (US5423041) (hereinafter "Burke") as cited in the previous Office Action, though the reference is not clearly indicated in the rejections of the present Office action. Thus, the rejection is improper for failing to particularly point out the claimed subject matter in view of the

references and the applicants' representative respectfully requests that the rejection be withdrawn or corrected with a new non-final Office Action.

Further, with regard to independent claim 1, in the present Office Action, the Examiner argues that Beaumont discloses *a rule composer ...creation and modification of a rule, the rule composer further receiving information... of creation and modification of the rule...* at paragraph [0123] and [0083]. **Again**, applicants' representative would like to direct the Examiner's attention to the reference and highlight that **there is neither a paragraph [0123] nor a paragraph [0083] disclosed in the reference.** *Beaumont contains a maximum of 64 paragraphs.* Therefore, the Examiner is incorrectly rejecting the claims based on a ***non-existent paragraph***. The Examiner further rejects claims 2-29 by referring at least in part to paragraphs which are ***non-existent and not disclosed*** in Beaumont. Therefore, the Examiner fails to particularly point out the claimed subject matter in view of the reference, and thus the rejection is improper. Accordingly, applicants' representative respectfully requests that the rejection be withdrawn or corrected with a new non-final Office Action.

However, for the sake of efficiently proceeding with prosecution of the subject application, the following arguments are also presented under the assumption that the above improprieties of the present Office Action will be corrected by issuing a new non-final Office Action properly pointing out the claimed subject matter in light of the cited art. The applicants' representative also respectfully requests withdrawal of this rejection for at least the following additional reasons.

Applicants' claimed invention relates generally to user friendly modeling of complex business rule(s) in a computer system. In particular, the present invention relates to a system and method for tree-based rule composition *with natural language inline editing*. For example, the system can combine a familiar hierarchical structure, such as a computer tree, and inline editing of natural language based logical expression(s) to provide a general purpose logical expression builder. In particular, independent claim 1, in part, recites a system facilitating rule composition comprising: *a rule composer that in response to a user input facilitates at least one of creation and modification of a rule, the rule composer further receiving information associated with the at least one of creation and modification of the rule based, at least in part, upon natural language inline editing.* Similar language is present in independent claims 22-24 and 25-26.

In review, Beaumont merely relates to systems and methods that permit credit card processing organizations to apply user friendly entry of rules into a user interface to design and administer credit card programs. Accordingly, Beaumont discloses a method of providing bankcard services that includes receiving at a host computer system a selection of a business rule from a library of business rules. The business rules may include information defining an event, a condition relating to at least one element associated with bankcard accounts, and information defining an action to be taken based on the condition upon the occurrence of the event. However, as is evidenced by the Examiner's retraction of the prior 35 U.S.C. § 102(e) rejection, Beaumont fails to disclose or anticipate at least the novel aspect of creating these rules by employing *natural language inline editing* as claimed. The Examiner turns to Burke to cure these deficiencies, however, Burke does not cure these deficiencies.

Turning to Burke, the reference generally relates to an Application Program Interface (API) for structuring a programming language based in part on rule-based programming. Burke states that rule-based programming is "another approach to programming" (*see* col. 1, ln. 22) in contrast to object-oriented programming and function-based programming. Thus, Burke is clearly discussing rule-based programming as a general programming architecture. To facilitate this general programming architecture, Burke presents a basic programming interface definition and states, "It would be advantageous if programmers could develop a problem domain ...and then develop rules to inference that domain...the rules could be directly coupled to an object-oriented application program, and the need to modify the application program would be minimal." (col. 1, ln. 44-50). Burke continues to describe writing rule-based code and then compiling it for execution, "the **programmer writes an application...then codes the rules...also codes a special header...inserts a rule calling sequence in the...program, which defines an inference class, binds an inference class object to a rule, adds user-defined class instances..., and calls an inference process...the rules are compiled with a rules compiler...that code is then compiled and linked into the application program.**" (col. 1, ln 55 – col. 2, ln 5, emphasis added). Clearly Burke is discussing a relatively low level of programming a computer to execute applications written in the rules-based language.

Burke cannot be considered analogous art and thus obvious *per se* has not been established.

Burke is in sharp contrast to the invention of Beaumont. Where Beaumont describes a user interface germane to unsophisticated users developing a credit card program, *Beaumont in no way implies that one of skill in low level rule-based programming is needed to set up a credit card offer*. Similarly, the development of rules in the instant application are also oriented to users and a user friendly environment *not necessitating some mastery of low-level programming techniques such as compiling, linking, and writing code in the native tongue of a low level API*. This can be evidenced in both Beaumont and the instant application by examining the user interfaces presented in each and the corresponding descriptions in the specifications, in which it is clear that the input for rule making is through a user friendly user interface and that there are numerous user interface options (*e.g.*, apply buttons, cancel buttons, help sections, discussion of using a mouse as a prominent means of interacting with the UI, ...) that are well understood by one of skill in the programming arts not to be associated with low level programming API's. Thus, the mere fact that Burke discusses rules and programming of rules near a computer is **not sufficient to rise to the level of making Burke analogous art** considering the vast difference between the various described inventions.

Burke cannot be combined with Beaumont to result in the disclosed subject matter without significant changes to Beaumont and thus obviousness *per se* has not been established.

Burke clearly describes their invention as needing to be programmed and compiled, as disclosed *supra*. In contrast, *Beaumont discloses forming rules by entering arguments, which can hardly be considered "programming", into a user interface, which can certainly not be considered "compiling"*. Further, Burke discloses **needing custom headers for the rules** (col. 8, ln. 61, not germane to the invention of Beaumont), **the presence of an inference engine** (col. 4, ln. 53-57, among others, also not germane to Beaumont), and that **the syntax of the rule is much like that of a C++ function** (col. 5, ln. 3-4, followed by a sample C++ style rule at ln. 8-22, clearly not germane to Beaumont). Thus, in order to combine the teachings of Burke into the teachings of Beaumont, the basic invention of Beaumont would necessarily be radically changed to accommodate the teachings of Burke. This is not permissible in a 35 U.S.C. § 103(a) rejection, and thus the rejection is improper as the Examiner has not presented a case of obviousness *per se*, where there is impermissible modification of the primary reference to combine the teachings.

Even where Burke *arguendo* presents a proper obviousness *per se* rejection, Burke fails to correct the deficiencies of Beaumont.

As stated *supra*, Burke teaches a rule-based programming interface and does not teach “creation and modification of the rule based... upon **natural language inline editing**”, as claimed in the rejected independent claims. The inline editing of natural language based logical expression(s) of the claimed invention can be combined with hierarchical tree structures to provide general purpose logical expression builder. As indicated by the Examiner by removing the prior 35 U.S.C. § 102(e) rejection, **Beaumont fails to disclose or anticipate any such natural language inline editing**. Beaumont merely discloses that clients can select pre-designed business rules, modify rules in the library, or create their own rules. Further, **Burke merely teaches that a rules-based programming can be combined with object-oriented programming to present an API for constructing a piece of software that is rules-based**. This is in no way comparable to *natural language inline editing* as it entails neither use of “natural language” (rather, in Burke, the language is a programming language such as C or C++) nor “inline editing” (rather, in Burke, the editing is at the function writing level prior to compiling executable code). Therefore, Burke also does not teach natural language inline editing and thus *does not correct the deficiencies of Beaumont*. Thus, Burke, either alone or in combination with Beaumont, neither explicitly nor implicitly teaches every aspect of the claimed invention.

Based on at least the foregoing, Beaumont in view of Burke fails to properly establish obviousness *per se* and further, in the alternative where *arguendo* obviousness *per se* is established, also fails to anticipate each and every element of the claimed subject matter as recited in independent claims 1, 22, 23, 24, 25, and 26 (and all claims which depend therefrom). Therefore, it is respectfully requested that the Examiner withdraw the rejection of claims 1-29 under 35 U.S.C. § 103(a) over Beaumont in view of Burke and pass the application to allowance at an early date.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP483US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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